

## **REMARKS**

This paper is responsive to the Office Action mailed January 30, 2007. Applicant would like to thank the Examiner, Mr. Grosso, and his supervisor for the telephone interview which occurred on Tuesday, March 20, 2007. All pending claims were discussed.

Applicant has withdrawn dependent claims 5, 13, 14, 18 and 23 in response to the Examiner's restriction requirement. However, should claims 1 and 4, as amended, be allowed, dependent claims 5, 13 and 14 should be reinstated because they are dependent from a generic allowed claim. Similarly, should independent claim 16, as amended, be allowed, dependent claims 18 and 23 should be reinstated because they depend from a generic allowed claim. The Examiner appears to agree that independent claim 1 is generic to dependent claims 5, 13 and 15 since Applicant made this argument in response to the Office Action mailed July 31, 2006 and the Examiner did not object. For the same reason, independent claim 16 is generic to dependent claims 18 and 23. Applicant has cancelled claims 7, 8, 11, 14, 20-23, 26, 28-35 and 38-44.

The Examiner rejected claims 1, 3, 4, 16, 17 and 45 under 35 USC 102(b) as being unpatentable over U.S. Patent No. 5,725,118 issued to Slager et al. In the Office Action mailed January 30, 2007 the Examiner wrote "The segment of sidewalls 14a and 14b and indicate at the lead line for 59 that extend into the opening constitute rectangular frames secured to opposing sides of the sleeve." This contradicts what the Examiner wrote in the earlier Office Action mailed July 31, 2006.

In the Office Action mailed July 31, 2006 the Examiner stated on page 5 "Slager does not teach the use of a frame secured to opposed sides of the sleeve defining the opening." The Examiner explained to Applicant's representative during the telephone interview on March 20, 2007 that the Examiner has changed his mind and now thinks that the Slager et al. reference

shows two rectangular frames, one on each side of the opening at the front of the container. The Examiner is wrong. Slager et al. does not have any rectangular frame. Applicant has amended independent claims 1, 16 and 51 to further define the rectangular frame as having an open interior. Support for this amendment is found on page 19, lines 10-11 and page 21, line 16 of the specification.

Applicant has amended independent claim 46 to further define over Slager et al. as suggested by the Examiner during the telephone interview on March 20, 2007. Applicant has amended independent claim 46 to require that a rectangular frame be secured to opposed sides of the sleeve with fasteners.

The Examiner rejected claim 15 under 35 USC 103(a) as being unpatentable over Slager et al. Applicant traverses this rejection for the following reasons.

First, the Examiner has not established a prima facie case of obviousness. The Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 24 USPQ.2d 1443, 1444 (Fed. Cir. 1992). Only if the Examiner meets this burden does the burden shift to applicant to come forward with evidence or an argument. Id. If examination at the initial stage does not produce a prima facie case of obviousness, then without more, the applicant is entitled to grant of the patent. Id. A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art at the time of the invention. In re Bell, 991 F.2d 781, 782, 26 USPQ2d. 1529, 1531 (Fed. Cir. 1993).

To properly combine references to make a prima facie case of obviousness, case law requires that there must have been some teaching, suggestion or inference in either one of the references, or both, or knowledge generally available to one of ordinary skill in the relevant art

which would have led one skilled in the art to combine the relevant teachings of the references.

See e.g. ACS Hospital Systems Inc. v. Montefiore Hospital, 221 USPQ 929, 933 (Fed. Cir. 1984); W.L. Gore & Associates v. Garlock, Inc., 220 USPQ 303, 311 (Fed. Cir. 1983); and In re Dembicza, 50 USPQ2d 1614 (Fed. Cir. 1999).

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Slager et al. container to incorporate a frame defining the horizontal opening of the container. Without such a teaching suggestion or inference in the Slager et al. patent, the rejection is improper.

If one were to incorporate a frame into the Slager et al. container, it would destroy the purpose of the Slager et al. container. As stated in column 2, lines 40-43 of Slager et al., the Slager et al. container (including the alternative embodiment of container shown in Fig. 3 having three side walls and one open side) is retrofittable to provide a shipping container having four solid sidewalls and vertical access through a top opening. As described in column 7, lines 12-26, the base 12 of the container has hinge structures 62 for securing additional side walls to the base 12 to form a four sided container. Such a hinge structure 62 is clearly shown in Fig. 3 of Slager et al. Thus, it is impossible to modify the alternative embodiment of Slager et al. shown in Fig. 3 to add a frame as the Examiner suggests in his rejection. When a reference may not be modified as the Examiner suggests in an obviousness rejection, the Examiner has not established a *prima facie* case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ.2d 1443, 1444 (Fed. Cir. 1992).

The combination of references is further improper because the Examiner has simply used applicant's claim as a blueprint to abstract bits and pieces of the prior art together, through hindsight to make the above obviousness rejection. It must be recognized that a

combination of prior art is improper and not “obvious” if the only suggestion or reason for combining the teachings of the prior art is to be found in the present application. In re Pye & Peterson, 148 USPQ 426 (CCPA 1966). Furthermore, it must be recognized that the fact that disclosures of references can be combined does not make the combination “obvious” unless the art also contains something to suggest the desirability of the combination. In re Rinchart, 189 USPQ 143 (CCPA 1976); In re Regal, 188 USPQ 136 (CCPA 1975); In re Avery, 186 USPQ 161 (CCPA 1975); In re Imperato, 179 USPQ 730 (CCPA 1973); and In re Andre, 144 USPQ 497 (CCPA 1965).

It is submitted that the Examiner has simply used the claims of this application as a blueprint and abstracted individual teachings from the cited pieces of prior art to create the combinations upon which he rejected the claims of the application. This was error as a matter of law. W.L. Gore, 220 USPQ at 312 (Fed. Cir. 1983).

The Examiner rejected dependent claim 2 under 35 USC 103(a) as being unpatentable over Slager et al. in view of U.S. Patent No. 6,827,231 issued to Budowski et al. Applicant traverses this rejection for the same reasons stated above with regard to Claim 1.

The Budowski et al. patent is directed to non-analogous art (minivan box liners) and teaches away from Slager et al. patent. In the Slager et al. container 10, two injection molded plastic sidewalls 14a, 14b, as well as sidewalls 14c, 14d which may be added, each of which may be hinged to base 12. See Slager et al, column 7, lines 10-27. Thus, a sleeve made of one piece of material like the one shown in Budowski et al. could not be used with the Slager et al. container because the sidewalls 14c, 14d of Slager et al. could not be removed from the container.

Furthermore, if one were to incorporate a one-piece sleeve into the Slager et al. container, it would destroy the purpose of the Slager et al. container. As stated in column 2, lines

40-43 of Slager et al., the Slager et al. container (including the alternative embodiment of container shown in Fig. 3 having three sidewalls and one open side) is retrofittable to provide a shipping container having four solid sidewalls and vertical access through a top opening. As described in column 7, lines 12-26, the base 12 of the container has hinge structures 62 for securing additional side walls to the base 12 to form a four sided container. Such a hinge structure 62 is clearly shown in Fig. 3 of Slager et al. Thus, it is impossible to modify the Slager et al. container so as to have a one-piece sleeve.

The Examiner rejected claims 6 and 19 under 35 USC 103(a) as being unpatentable over Slager et al. in view of U.S. Patent No. 6,540,096 issued to Bazany et al. Applicant traverses this rejection for the same reasons stated above with regard to independent claims 1 and 16.

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Slager et al. container to incorporate dunnage comprising pouches. Without such a teaching suggestion or inference in the Slager et al. patent, the combination of references used by the Examiner is improper.

The Examiner rejected claims 9, 10, 25 and 25 under 35 USC 103(a) as being unpatentable over Slager et al. in view of U.S. Patent No. 4,828,132 issued to Francis, Jr. et al. Applicant traverses this rejection for the same reasons stated above with regard to independent claims 1 and 16.

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Slager et al. container to incorporate a sleeve made of corrugated plastic wherein the corrugations extend vertically. Without such a teaching, suggestion or inference in the Slager et al. patent, the combination of references used by the Examiner is

improper.

The Examiner rejected claim 12 under 35 USC 103(a) as being unpatentable over Slager et al. in view in view of U.S. Patent No. 1,163,696 issued to Silberman. Applicant traverses this rejection for the same reasons stated above with regard to Claim 1.

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Slager et al. container, as modified, to incorporate fasteners for securing a sleeve to the pallet base. Without such a teaching, suggestion or inference in the Slager et al. patent, as modified, the combination of references used by the Examiner is improper.

The Examiner rejected claim 27 under 35 USC 103(a) as being unpatentable over Slager et al. as modified by Francis, Jr. in view of Silberman. Applicant traverses this rejection for the same reasons stated above with regard to independent claim 16.

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Slager et al. container, as modified, to incorporate fasteners for securing a sleeve to the pallet base. Without such a teaching, suggestion or inference in the Slager et al. patent, as modified, the combination of references used by the Examiner is improper.

The Examiner rejected claims 36 and 37 under 35 USC 103(a) as being unpatentable over Slager et al. in view of Francis, Jr. Applicant traverses this rejection for the same reasons stated above with regard to independent claims 1 and 16.

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Slager et al. container, as modified, to incorporate a pallet base and pallet cover each having a lip. Without such a teaching, suggestion or inference in the Slager et al. patent, as modified, the combination of references used by the Examiner is improper.

The Examiner rejected claims 46-49 under 35 USC 103(a) as being unpatentable

over Slager et al. as modified by Francis, Jr. in view of Silberman. Applicant traverses this rejection for the same reasons stated above with regard to independent claims 1 and 16.

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Slager et al. container, as modified, to incorporate fasteners for securing a sleeve to the pallet base. Without such a teaching, suggestion or inference in the Slager et al. patent, as modified, the combination of references used by the Examiner is improper.

The Examiner rejected dependent claim 50 under 35 USC 103(a) as being unpatentable over Slager et al. as modified by Francis, Jr. and Silberman in view of Bazany et al. Applicant traverses this rejection for the same reasons stated above with regard to independent claims 1 and 16.

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Slager et al. container, as modified, to incorporate fasteners for securing a sleeve to the pallet base. Without such a teaching, suggestion or inference in the Slager et al. patent, as modified, the combination of references used by the Examiner is improper.

The Examiner rejected claims 51-53 and 55 under 35 USC 103(a) as being unpatentable over Slager et al. as modified by Francis, Jr. in view of Silberman. Applicant traverses this rejection for the same reasons stated above with regard to independent claims 1 and 16.

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Slager et al. container, as modified, to incorporate fasteners for securing a sleeve to the pallet base. Without such a teaching, suggestion or inference in the Slager et al. patent, as modified, the combination of references used by the Examiner is improper.

The Examiner rejected dependent claim 54 under 35 USC 103(a) as being

unpatentable over Slager et al. as modified by Francis, Jr. in view of Silberman. Applicant traverses this rejection for the same reasons stated above with regard to independent claims 1 and 16.

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Slager et al. container, as modified, to incorporate fasteners for securing a sleeve to the pallet base. Without such a teaching, suggestion or inference in the Slager et al. patent, as modified, the combination of references used by the Examiner is improper.

If any charges or credits are necessary to complete this communication, please apply them to Deposit Account No. 23-3000. If any questions remain, or the Examiner wishes to discuss this matter, a telephone call to undersigned would be greatly appreciated.

Respectfully submitted,

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